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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,474	02/11/2002	Brian F. Colin	3356-84986	4371

7590 05/17/2004

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EXAMINER	
SAGER, MARK ALAN	

ART UNIT	PAPER NUMBER
3714	4

DATE MAILED: 05/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/073,474	COLIN ET AL.	
	Examiner	Art Unit	
	M. A. Sager	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 February 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the [means for] displaying indicia of a winning combination of items present within the plurality of items in advance of selection (clm 1, 14, 27), [means for] displaying the indicia... randomly selecting... selected items (clm 13, 26), second display area... a winning criteria... non-selected items (clm 30), as claimed, must be shown or the feature(s) canceled from the claim(s). This is not a lack of enablement issue, but rather it is an objection grounded in public policy that the claimed invention be illustrated for the illiterate to comprehend the claimed invention. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: [means for] grouping (claim 6, 19), [means for] displaying a name of only a relatively highest level winning combination (claim 12, 25), [means for] displaying the indicia of the possible winning combination further comprises [means for] randomly selecting the winning combination (claim 13, 26) and second display area... a winning criteria... non-selected items (clm 30), as presently claimed.

Claim Objections

3. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 6 (second occurrence) has been renumbered claim 7.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 13, 26 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for [means for] displaying the indicia of the possible winning combination and enabling for [means for] randomly selecting the winning combination from a plurality of winning combination within the selected item, does not reasonably provide enablement for the displaying comprising the randomly selecting function/structure in that it is not taught/disclosed that the selection is part of the displaying. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention commensurate in scope with these claims. Also, the specification teaches or enables that the player randomly selects items from the plurality of items that further teaches that the displaying does not comprise the randomly selecting function/structure. In addition, it is noted that the specification discloses that a subset of items may be used (paragraph 29, page 10-11);

however, it does not teach or suggest that a selection of winning combination is conducted by the machine since it merely states that a statistical minimum number of items is provided to assure at least one winning combination and no discussion that the items are randomly selected to achieve a predetermined win rank.

6. Claim 30 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for second display area and a winning criteria, does not reasonably provide enablement for second display comprises winning criteria. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention commensurate in scope with these claims. Specifically, a processor or processing device or at least a memory contains the winning criteria used by a processor or processing device to identify winning combination but a display or display area does not comprise winning criteria, as disclosed/claimed.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 7-13, 20-26, 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 7-13, 20-26 recites the limitation "the possible" in line 2. There is insufficient antecedent basis for this limitation in the claim. It is unclear whether 'the possible' modifies winning combination to suggest another winning combination in addition to winning combination of claim 1, 14. For examination purposes, possible winning combination is same as winning combination in so far as player has potential or possible winning

combination that may be achieved. Claim 30 recites the limitation "the second display area" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim interpretation follows. First, [means for] displaying indicia of a [potential] winning combination... in advance of selection of any item of the plurality of items as best understood appears to include a win or pay table or schedule which are provided prior to play such as displayed on video terminal or paper handout/booklet. The means for displaying is either

programming of a video display or printing on paper or etching on belly glass since disclosure includes video and paper embodiment. Second, [means for] moving items as best understood appears to be programmed display of item from first area to a second area since there is no physical item in both electronic/video and paper embodiment to actually move, the moving is a preprogrammed appearance that a displayed/printed item is located or duplicated to second or another area. Third, [means for] grouping the selected items in the second display according to any winning combinations present within the selected items as best understood appears to be win determination/association so as to categorize/associate or group the selected elements to a win or pay table or schedule to ascertain if any winning combination of elements have been selected. Fourth, displaying a name of only a relatively highest level winning combination of items as best understood appears to be a win or pay table or schedule. Fifth, [means for] randomly selecting the winning combination from a plurality of winning combination within the selected items as best understood appears to include player randomly selecting a winning combination from a set of winning combinations and displaying the indicia of the possible winning combination such as a pay or win table or schedule. Finally, second display area comprises a winning criteria adapted to identify winning combination within the plurality of non-selected items as best understood appears to include a win or pay table/schedule for the non-selected items. This may also include a prognostic or precognition or predictive display of winning combination in process or soon to be won or displayed.

12. Claim 1-30 is rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hamano (4560161). First, it is noted 'a video game of chance' (clm 2-13, 15-26) is preamble language that fails to breath life and

meaning into claimed invention. Where a video game of chance is preamble that fails to breath life and meaning into the claims since it is not 'essential to point out the invention defined by the claim'. *Kropa v. Robie*, 88 USPQ 478, 481 (CCPA 1951). Further, it does not limit the structure of the claimed device. *In re Stencel*, 4 USPQ2d 1071 (Fed. Cir. 1987). Finally, it recites an intended use of structure where the claim body does not depend on the preamble for completeness such that the structural limitations stand alone. *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976). However, Hamano teaches a method/apparatus for playing a video game of chance such as poker (figs. 1-6) comprising [means for] providing a plurality of items that until selected define a set of non-selected items (non-selected card images, fig. 6(1)), [means for] displaying indicia of a [potential] winning combination of items present within the plurality of items in advance of selection of any item of the plurality of items (inherent) and [means for] enabling the one player to select at least some of the plurality of items for inclusion in a set of selected items, wherein at least one other of the plurality of items remains within the set of non-selected items (figs. 1-6), where selected item is copied to a second area so as to appear to move to a selected hand area (Z) that is programmed function to display selected item in another area thereby appearing to 'move' to second area, and the selected items are grouped or categorized according to winning combination as conventional for hand ranking of video poker (2:27-3:53, figs. 1-6). Applicants admission regarding video poker is played by a single player and is not played against a dealer or any other player where payouts are based exclusively upon the cards selected by the player and upon the odds of obtaining any particular hand (paragraph 28, page 10) is noted. By Official Notice, single player games of chance (whether slot/fruit or poker or other) conventionally display a win or pay table or schedule as either a paper pamphlet/sheet or

as displayed on terminal for player to know items which make up a win combination, the name of win combination and its corresponding payout. Examples include conventional slot/fruit or poker machine which display winning combination, its name and its payout. Thus, the single player video poker apparatus cited by Applicant and similarly Hamano's gaming machine each inherently possess [means for] displaying indicia of a [potential] winning combination of items present within the plurality of items in advance of selection of any item of the plurality of items as either a paper notice or display of win or pay table/schedule of the items for winning combination, its associated name and its associated payout.

Alternatively, regarding [means for] displaying indicia, it was conventional for single player slot/fruit or poker machines to provide a [means for] display of indicia of a [potential] winning combination of items present within the plurality of items in advance of selection of any item of the plurality of items so as to inform player of win criteria so as to notify player what constitutes a winning combination, its name of win and its corresponding payoff. It would have been obvious to an artisan at a time prior to the invention to add [means for] display of indicia of a [potential] winning combination of items present within the plurality of items in advance of selection of any item of the plurality of items to Hamano's gaming machine so as to notify player what constitutes a winning combination, its name and its corresponding payout.

Alternatively regarding moving items, simulating movement is well known in gaming via electronic animation/simulation or printing animated image. By Official Notice, simulating action such as movement enhances realism and players enjoyment from improved action portrayal, as noted in comics, animation, cartoons or gaming. In electronic format, screen wipes or morphing or animation of movement was notoriously well known as techniques used to

enhance realism of action such as moving images. In paper format, printing image in an altered form to enhance suggestion of movement was common in literature. It would have been obvious to an artisan at a time prior to the invention to add moving items from the first display area to the second display area as they are selected by the one player to Hamano's gaming machine to enhance realism of action and thus increase player's enjoyment therefrom and increase revenue from increased play thereby.

Finally, Hamano teaches [means for] randomly selecting the winning combination from a plurality of winning combination within the selected items as best understood as being a player randomly selecting a winning combination from a plurality of winning combinations (figs. 1-6) in the non-selected items as selected items and displaying the indicia of the possible winning combination such as a pay or win table or schedule (supra, displaying a pay or win table/schedule).

Response to Arguments

13. Applicant has failed to claim differences over prior art in a manner that is clear and enabled to overcome art.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Aruze Corporation and Universal Sales Co., Ltd. each discloses game devices possessing prognostic or precognitive or predictive displays to announce a soon to be displayed win.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 703-308-0785. The examiner can normally be reached on T-F, 0700-1700 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. A. Sager
Primary Examiner
Art Unit 3714

MAS